



Attorney Docket: 178/50615
PATENT

9

16

6-2-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: VOLKER ERNST ET AL.
Serial No.: 09/988,825 Group Art Unit: 1724
Filed: NOVEMBER 20, 2001 Examiner: Minh Chau Thi PHAM
Title: SEPARATOR FOR LIQUIDS COMPRISING A SEPARATING
CARTRIDGE, PARTICULARLY FOR SEPARATING OIL FROM
CRANKCASE GASES

REPLY

Commissioner for Patents
Washington, D.C. 20231

Sir:

The following remarks are respectfully submitted in response to the Office
Action dated October 25, 2002.

Claims 1-10 and 14-18 were rejected under 35 U.S.C. §103(a) as being
unpatentable over Jones (U.S. Patent 4,080,071) in view of DE 232 45 75 B2.
For the following reasons, Applicants respectfully request reconsideration of the
rejection.

Claims 1-10 and 14-18 each recite various patentable features not taught
or suggested by the cited references. For example, each of the independent
claims (i.e. claims 1 and 17) recites that the end disks engage the mount to form
a seal and together with the support member form a sealed assembly. The cited
references, on the other hand, do not teach or suggest an end disk that engages a
mount to form a seal. In addition, claim 1 recites that the mount is constructed
as a nipple that is gas permeable in the area between the end disks of the
separating cartridge. The cited references do not teach or suggest a mount that
is constructed as a nipple. Accordingly, the cited references do not teach every

RECEIVED
MAR 21 2003
TC 1700 MAIL ROOM

limitation of the claimed invention, and reconsideration of this rejection is respectfully requested.

Claims 11-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Jones in view of DE 232 45 75 B2 as applied to claims 1-10 and 14-18, further in view of Gewiss et al. (U.S. Patent 5,413,712). Since this rejection relies on the propriety of the first rejection, this rejection is improper because, as discussed above, the first rejection is improper. Therefore, reconsideration and withdrawal of this rejection is respectfully requested.

Withdrawal of the rejections is also respectfully requested for the following reason. Although Applicants have carefully reviewed the Office Action, Applicants have not been able to clearly identify the basis for the rejection. Specifically, it is not clear to Applicants what components of the prior art filters the Office Action considered to correspond to the elements of the claimed liquid separator.

The MPEP requires that the Examiner properly communicate the basis for a rejection so that Applicants can be given a fair opportunity to reply (see MPEP 706.02(j)). The MPEP further requires that where a claim is refused or any reason relating to the merits thereof the ground of rejection should be fully and clearly stated (see MPEP 707.07(d)).

Applicants respectfully submit that the Office Action does not meet the requirements of the MPEP. The Office Action only provides a list of reference numerals used in the references and certain sections of the references, and a verbatim recitation of the rejected claims. However, the Office Action failed to specifically state what components of the prior art filters are considered to correspond to the elements of the claimed liquid separator. For example, what components of Jones' filter are considered to be the mount, support member, end disks, and nipple?

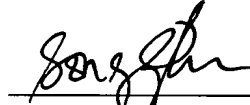
To avoid any misunderstanding, Applicants respectfully request that the Office Action be withdrawn and a new Office Action be issued clearly stating the basis for the rejections.

In light of the foregoing remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #178/50615).

Respectfully submitted,

March 11, 2003



Song Zhu, Ph.D.

Registration No. 44,420

J. D. Evans

Registration No. 26,269

CROWELL & MORING, LLP
Intellectual Property Group
P.O. Box 14300
Washington, DC 20044-4300
Telephone No.: (202) 624-2500
Facsimile No.: (202) 628-8844
JDE:SZ:tlm (037141.50615US)